

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

ANDREW E. FANO)	
Appellant,)	
)	Attorney Docket No.: 33836.00.0032
)	Serial No.: 10/064,477
)	Filing Date: Jul. 18, 2002
)	
)	Title: Media Indexing Beacon and
)	Capture Device
CINDY NGUYEN)	
Examiner.)	
ART UNIT: 2161)	
)	

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The instant Reply Brief is in response to the Examiner's Answer mailed on June 11, 2008.

Because the Examiner's Answer has, at various points, set forth characterizations of the references and arguments that differ from those characterizations and arguments presented in the Final Office Action, (mailed Dec. 12, 2007), of record, [hereinafter "Final"], Appellant submits the instant Reply Brief to address those points.

1.) Return to Past USPTO Argument in Examiner's Answer With Respect To Cobbley

The Appellant respectfully submits that the issue of whether Cobbley discloses "index information separate from the media file from an external source" has already been addressed in the record, and conceded by the USPTO.

The Examiner's Answer states that, "Cobbley didn't disclose; an event indicator that a specific event is occurring." See Examiner's Answer, page 4, [hereinafter "EA"]. However, the Final Office Action of Dec. 12, 2007 stated that, "Cobbly didn't disclose: index information separate from the media file from an external source (105, fig. 1) related to the subject and comprising an event indicator that a specific event is occurring." See Final, at 3; See also Appeal Brief, page 12, ¶ 4. The Examiner's Answer also states that in response to Appellant's argument that Narayanaswami does not teach "index information separate from the media file . . .," the "Examiner maintained the rejection above that both Cobbley and Narayanaswami teaching index information separate from the media file from an external source related to the subject." See EA, page 14, ¶ B {emphasis added}. The Examiner however is not maintaining the position of the Final Office Action with respect to Cobbley but is returning to position taken in the Office Action mailed on Jul. 26, 2007.

The Appellant has previously addressed the question of whether Cobbley disclosed "index information separate from the media file from an external source" in Appellant's Response to the USPTO Office Action mailed on Jul. 26, 2007, of record, pages 11 to 12 (dated Oct. 26, 2007), [hereinafter "Appellant's October 2007 Response"]. There, Appellant

demonstrated that Cobbley, in fact, does not teach index information separate from the media file from an external source. Rather, Cobbley states that the indexing information is obtained from the broadcast information which is *transmitted concurrently* with the broadcast information.

See Cobbley, col. 6, lines 12-21; Appellant's October 2007 Response, of record, page 12.

Subsequently, in response to Appellant's argument regarding Cobbley, the Examiner conceded and admitted that Cobbley did not disclose "index information separate from the media file from an external source." See Final, at 3. The Examiner therefore cited Narayanaswami as disclosing this claim feature. See Final, at 3. The Examiner's Answer now states that both Cobbley and Narayanaswami teach this feature. See EA, at 14, ¶ (10)B.

The Appellant respectfully submits that returning to the reasoning of the prior Office Action of July 26, 2007, takes the discussion in circles such that the Appellant can not be certain what issues have been resolved in the record per the USPTO's understanding. Although the Appellant understands that the basis of rejections may be reformulated by the USPTO using the same cited references, the Appellant must, in the interest of fairness, have some way of knowing when Appellant's previous arguments of record have been accepted such that prosecution of an application may proceed in a reasonable manner. Therefore the Appellant respectfully submits that the fact that Cobbley does not disclose "index information separate from the media file from an external source" has already been addressed in the record, and conceded by the USPTO.

The Appellant's Appeal Brief nonetheless provides details on this point in its summary of the Cobbley reference. Cobbley discloses that, the "indexing information is transmitted by the broadcast source 105 concurrently with the video and/or audio news broadcast." See Cobbley, col. 4, lines 13-15. See also Appeal Brief, page 9, ¶2. Cobbley's index data capture device "obtains the indexing information from the broadcast information. Id. col. 6, lines 12-14. See also Appeal Brief, page 10.

With respect to Narayanaswami, the only section of Narayanaswami that mentions indexing information used for searching is found in Narayanaswami, page 4, ¶ 0042. However, Appellant discusses, in its Appeal Brief, the larger disclosure of Narayanaswami and its definition of watermarking information as hidden information, and whether this would properly be understood as indexing information. See Appeal Brief, pages 13 and 14. Appellant respectfully submits that, with respect to the “indexing information” of the claim terminology, this is the more pertinent issue requiring a determination by this Board than is the disclosure of Cobbley.

2.) Revision of USPTO Argument in Examiner’s Answer With Respect To Motivation to Combine

The Examiner’s Answer has revised the motivation to combine with respect to Cobbley and Narayanaswami and now addresses motivation with respect to “an event indicator that a specific event is occurring” and states that, “The motivation being to enable the system [to] provide a method [that] allows the recorded parameter to be watermarked into every captured image, which parameters may then be later used for verifying the authenticity of pictures, as well as for indexing and searching photo albums (see paragraph 0042, lines 24-30, Narayanaswami).” See EA, page 4 {emphasis added}. The Final Office Action stated the motivation as “being to enable the system [to] provide a[n] automatic recording [of] a plurality of camera and image parameters (index information such as time, date, location) with each captured image.” See Final, page 4.

Therefore the previous incarnation of motivation to combine did not use the term “watermarked.” However, Appellant’s arguments presented in the Appeal Brief are still applicable:

Modifying the Cobbley system by adding watermarking data to the media files would not result in the Applicant's claimed invention because the watermarking data of Narayanaswami must be hidden within the media files. Therefore, adding the watermarking data of Narayanaswami could not result in having "indexing information" associated with the media file and suitable for establishing a searchable system.

See Appeal Brief, page 16, ¶ 6. Therefore, it is evident that the new motivation to combine presented in the EA is premised on a faulty application of the teachings of Narayanaswami taken as a whole, which teaches that watermark information is hidden information, and therefore this new motivation to combine is equally faulty.

Regarding the "event indicator," this terminology is addressed in the Appeal Brief, pages 14 to 15 and the Appellant respectfully reiterates its arguments presented therein. Appellant submits that the interpretation of "an event indicator that a specific event is occurring" as "geographic position, (e.g., latitude, longitude, and altitude) of the camera . . . time and date and local time and date when an image is taken . . ." are not "an event indicator that a specific even is occurring" as recited by the claims. See Final, at 3. Time and geography alone are not an "event indicator that a specific event is occurring" as would be understood by anyone let alone one of ordinary skill, and this interpretation of the claim language is unreasonable.

3.) Change in the USPTO Argument in Examiner's Answer With Respect To Cobbley's disclosure of "at least one index buffer" with respect to claims 21 and 22 and the dropping of the Katseff reference in the newly stated rejection

The Examiner's Answer states that, "Cobbley disclose: at least one index buffer comprising the index information (128, fig. 1, Cobbley); and a transmitter operably coupled to the at least one index buffer (110, fig. 1 and corresponding text), wherein the transmitter provides the index information to the media capture device (112, fig. 1)." See EA, pages 11-12.

However, the presently appealed Final recites a different story. In particular, the Final states that, “Cobbley/Narayanaswami didn’t disclose: wherein the media indexing beacon further comprises: at least one index buffer comprising the index information; and a transmitter operably coupled to the at least one index buffer, wherein the transmitter provides the index information to the media capture device.” See Final, page 11 {emphasis added}; See also Appeal Brief, page 22, ¶ 10a. In the Final, the Examiner therefore cited Katseff as disclosing the at least one index buffer. See Final, page 11. However, in the EA, the Katseff reference has apparently been dropped with respect to the claim 21 and 22 rejections.

Appellant believes the Examiner’s withdrawal of the Katseff reference in formulating the rejection of claim 21 in the Examiner’s Answer operates as a withdrawal of the claim 21 rejection. “[W]ithdrawal of a reference upon which a rejection is based unequivocally withdraws that rejection.” In re Flint, 330 F.2d 363, 365 (C.C.P.A. 1964).

In Flint, an Examiner, in a final rejection, relied on two references, Pollack and Ball. See Id. The Examiner rejected all claims in the application as unpatentable over Pollack in view of Ball. See Id. In the Examiner’s Answer, on appeal before this Board, “the Examiner dropped the patent to Ball as a reference and relied solely on the patent to Pollack.” See Id. The Examiner did not officially withdraw the rejection based on Pollack and Ball. See Id. The C.C.P.A. stated that, “[w]e think withdrawal of a reference upon which a rejection is based unequivocally withdraws that rejection.” Id. The C.C.P.A. also noted that “Appellant’s mentioning the rejection on the Ball patent in the reasons of appeal can in no wise resurrect a withdrawal ground of rejection and can readily be explained by counsel’s justified caution . . . to avoid any possibility of not being heard on the merits of what the Patent Office might still consider a viable rejection.” Id.

Appellant notes that the C.C.P.A. further stated that, “[s]ince the examiner dropped Ball and the board in no way relied on it, we regard that reference as out of the case.” Id. Appellant thus infers from the C.C.P.A.’s language that this Board may, in its discretion, still rely on Katseff, despite the withdrawal of the rejection made by the Examiner in the EA. The Appellant however respectfully submits to this Board that, because the EA now changes the argument to be contrary to the position previously taken by the USPTO in the Final with respect to Cobbley and Narayanaswami, the Appellant is again placed in a position where it can not be certain what issues have been resolved in the record per the USPTO’s understanding and corresponding statements and admissions made by the USPTO in the record prior to Appeal.

The Appellant therefore exercises its caution with respect to these new allegations, as the C.C.P.A. found to be justified, and notes that, even if the rejection is not deemed withdrawn, Cobbley does not teach what is alleged in the Examiner’s Answer. Inspection of Cobbley, Figure 1, shows that the “cache index 128” is connected to a “cache manager 125.” The “cache manager 125” is connected to the “capture device 115” and the “index data capture device 112,” both of which are connected to the “broadcast receiver 110.” See Cobbley, Figure 1. The “broadcast receiver 110” receives a signal “107” from a “broadcast source 105.” See Cobbley, Figure 1. “Broadcast source 105 transmits the broadcast information over a transmission medium 107 to broadcast receiver 110.” See Cobbley, col. 3, lines 37-40.

Therefore the components of Cobbley Figure 1 referred to in the Examiner’s Answer are on a receiving equipment side, rather than on a transmitting equipment side. The “cache index 128” is described as storing indexing information for received information. See Cobbley, col. 7, lines 65 to col. 8, line 3. Appellants claim 21 recites “a media indexing beacon which generates a beacon signal containing index information relating to a subject and comprising an event indicator that a specific event is occurring; and wherein the media indexing beacon further

comprises at least one index buffer comprising the index information; and a transmitter operably coupled to the at least one index buffer, wherein the transmitter provides the index information to the media capture device.” Cobbley also does not show a coupling between the transmitter and the “cache index 128” because component 128 is a receiver side component in Cobbley’s description. See Cobbley, Figure 1.

Likewise in the interest of caution and to ensure being heard on the merits, Appellant addresses Katseff which was cited in the Final Office Action as disclosing the “at least one index buffer” in col. 15, lines 16-37. See Final, page 11.

Katseff states that:

In a preferred embodiment, the video process utilizes a data buffer monitoring subroutine, illustrated in FIG 10, to maintain a pre-defined amount of audio and video data in the audio and video buffers 110, 115. The data buffer monitoring subroutine will continuously monitor the audio and video buffers 110, 115 during step 1000, until the amount of audio or video data stored in the audio or video buffers 110, 115 drops below a predefined threshold value, as detected by step 1010.

See Katseff, col. 15, lines 16-37.

Therefore, although Katseff discloses a “data buffer” and “audio and video buffers,” the above-quoted portion of Katseff clearly demonstrates that Katseff’s teachings in this regard are wholly unrelated to “a transmitter operably coupled to the at least one index buffer, wherein the transmitter provides the index information to the media capture device.”

4.) The Examiner’s Answer does not properly address Appellant’s arguments with respect to claims 8, 13, 19, 25, 27 and 29

In the Appeal Brief, page 19, ¶ 8 and onward, the Appellant has discussed how Cobbley does not describe an “index information request” as required by claims 8 and 13. The Examiner’s Answer fails to address this discussion and merely states that, “Appellant’s

arguments with regards to the rejection of claims 8 and 13 is similar to those presented with respect to claims 1 and 5 addressed above.” See EA, page 19, ¶ G.

For an Examiner’s Answer, it is required that:

(d) For each rejection under 35 U.S.C. 103, the examiner’s answer must:

(i) state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on in the rejection,

(ii) identify the differences between the rejected claims and the prior art relied on (i.e., the primary reference), and

(iii) explain why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter.”

(e) “For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to a specific page, line number, drawing reference number, and quotation from the prior art, as appropriate.

See MPEP § 1207.02 (A)(9), page 1200-29 (Rev. 3, August 2005) {emphasis added}.

Therefore, the Examiner’s Answer, page 19, ¶¶ G., H., and, although to a lesser extent, ¶ I., improperly gloss over the discussions presented in the Appeal Brief and therefore also fail to address specific features of the argued claims that render these claims not merely “similar” to other claims of the patent application. The Appellant has certainly raised questions in the Appeal Brief as to how the USPTO believes limitations in the claims allegedly correspond to features in the cited references.

The Appellant respectfully refers the Board to the Appeal Brief, page 19, ¶ A8 regarding claims 8 and 13, and page 21, ¶ A9 regarding claims 19, 25, 27 and 29.

Appellant respectfully requests that the instant appeal be maintained before the Board. Appellant maintains that the preponderance of evidence lies in favor of non-obviousness of the

claims and that this Board should therefore overturn the obviousness rejections, or provide any relief the Board deems fair and equitable in light of the arguments presented in the Appeal Brief and the instant Reply Brief.

Respectfully submitted,

Andrew E. Fano

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Vedder Price P.C.
222 N. LaSalle St., Suite 2600
Chicago, Illinois 60601

By: /Christopher P. Moreno/
Christopher P. Moreno
Registration No. 38,566
Phone: (312) 609-7842
Fax: (312) 609-5005